

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-4 are pending in this application. Claims 1 and 2 are independent. The remaining claims depend, directly or indirectly, from claim 2.

Claim Amendments

Independent claims 1 and 2 have been amended by way of this reply to clarify the claimed invention. No new subject matter has been added by way of these amendments, as support for these amendments may be found, for example, in the claims and in paragraphs [0045]-[0046] of the publication of the Specification. Additionally, claims 3 and 4 have been amended to correspond to amendments made to claims 1 and 2. No new subject matter has been added by way of these amendments.

Rejection(s) under 35 U.S.C. § 112

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-4 have been amended in this reply to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Specifically, the Examiner has rejected claim 1 in view of the expressions “a kind” and “a kind of operation.” As amended, claim 1 is directed to a receiving device (1)

configured to receive a signal transmitted from an external transmission device (e.g., remote controller 50) to execute a corresponding operation. Limitations relating to “a kind” and “a kind of operation” have been amended to clarify differences between signals and kinds of signals, as well as between corresponding operations and kinds of corresponding operations.

Accordingly, Applicant asserts that, as amended, claim 1 clearly points out and distinctly claims the subject matter which Applicant regards as the invention. Accordingly, withdrawal of the §112, second paragraph, rejection with respect to claim 1 is respectfully requested. Claims 2-4, noted by the Examiner as corresponding to claim 1, were rejected by the Examiner for reasons similar to claim 1. Claims 2-4 have been amended by way of this reply to have amendments similar to claim 1. Accordingly, withdrawal of the §112, second paragraph, rejection with respect to claims 2-4 is respectfully requested.

Rejection(s) under 35 U.S.C. § 103

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,731,654 issued to Itabashi *et al.* (hereinafter “Itabashi”) in view of a machine translation of Japanese Patent Application publication No 05-197470 in the name of Katsuhisa (hereinafter “Katsuhisa”). Independent claims 1 and 2 have been amended in this reply to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As discussed above, one or more embodiments of the present invention are directed to a receiving device (1) configured to receive a signal transmitted from an external transmission device (e.g., remote controller 50) to execute a corresponding operation. Upon receipt of a command from the external transmission device, a received signal may be converted into an operation other than the previously allocated corresponding operation, if the previously

allocated corresponding operation is an operation that should not be changed (e.g., power on/off) (*see, e.g.*, Publication of the Specification, paragraphs [0028], [0044]-[0046]).

Accordingly, amended independent claim 1 requires a receiving unit configured to receive the signal transmitted from the external transmission device and a converting unit configured to convert the received signal into the corresponding operation to be executed by the receiving device. Further, claim 1 requires that the converting unit is configured to convert the received signal into one of the plurality of kinds of operations other than the corresponding operation, based on the correspondence in the first storage unit. Further, claim 1 requires that if the request from the external transmission device corresponds to changing the kind of signal stored in the second storage unit, of which the corresponding kind of operation should not be changed, the storage changing unit announces, before changing the correspondence in the first storage unit, that the correspondence should not be changed.

Itabashi, in contrast to the present invention, does not show or suggest at least limitations relating to changing a kind of signal stored in a storage unit, as required by claim 1. In fact, the Examiner acknowledges that Itabashi fails to show or suggest these limitations. Further, Itabashi fails to show at least converting the received signal into one of the plurality of kinds of operations other than the corresponding operation, based on said correspondence in said first storage unit, as required by independent claim 1. In fact, Itabashi fails to disclose a first or second storage unit as required by the claimed invention. In contrast to the claimed invention, Itabashi is directed to non-volatile memory and setting initial data in the memory so that spurious elements will not cause damage to a receiver (*see* Itabashi, Abstract). Itabashi merely shows retrieving stored offset values in memory which are supplied to a microcomputer (20) to modify display values (e.g., brightness) onscreen (*see* Itabashi, col. 4, lines 15-43). Thus, Itabashi fails to show or suggest all of the limitations of amended claim 1.

Additionally, Applicant respectfully asserts that Itabashi is non-analogous art to the present application. Although Itabashi is directed to televisions and remote controls, Itabashi does not address issues such as, for example, converting a received signal into one of a plurality of kinds of operations other than the corresponding operation, as required by the claimed invention. In clear contrast, as discussed above, Itabashi is directed to adjusting control values such as brightness, and retrieving stored offsets for the control values from memory. *See, e.g.*, “Analogy in the Electrical Arts,” MPEP 2141.01(a). Accordingly, as Itabashi is not in the same field of endeavor as the claimed invention and is not reasonably pertinent to the particular problem with which the present inventor was faced, Itabashi cannot properly be applied in an obviousness rejection against the present claims.

Katsuhisa also does not show or suggest at least converting the received signal into one of the plurality of kinds of operations other than the corresponding operation, based on said correspondence in said first storage unit, as required by independent claim 1. Further, Katsuhisa fails to show or suggest a first or second storage unit as required by the claimed invention. Thus, Katsuhisa fails to render the present claims obvious or supply that which Itabashi lacks.

Further, Applicant respectfully asserts that Katsuhisa is non-analogous art to the present application. Katsuhisa is directed to keyboards used with touch-screen displays, and wholly fails to address issues related to televisions and remote controls. Accordingly, as Katsuhisa is not in the same field of endeavor as the claimed invention and is not reasonably pertinent to the particular problem with which the present inventor was faced, Katsuhisa cannot properly be applied in an obviousness rejection against the present claims.

Finally, Applicant respectfully notes that there is no motivation to combine the cited references. The Examiner cannot combine prior art references to render a claimed

invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. There must be a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must be an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used as a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

One skilled in the art would not be motivated by Itabashi, which is completely silent with respect to converting a received signal into another kind of operation, to incorporate the teachings of Katsuhisa, which relates to keyboards used with touch-screen displays, without the present application as a guide. Itabashi provides no motivation to convert a received signal as required by the claimed invention, and Katsuhisa provides no motivation to incorporate its teachings into a receiver system. Thus, one skilled in the art would not be motivated to incorporate the teachings of Itabashi and Katsuhisa without the present application as a guide. Thus, there exists no proper motivation to combine the cited references in a rejection against the present claims.

In view of the above, (i) Itabashi and Katsuhisa are improper non-analogous art; (ii) the combination of Itabashi and Katsuhisa is improper as there exists no motivation to combine the references; and (iii) Itabashi and Katsuhisa, whether taken separately or in combination, fail to show or suggest the invention as recited in amended independent claim 1. Thus, amended independent claim 1 is patentable over Itabashi and Katsuhisa. Claim 2, rejected for the same reasons as for claim 1, is also allowable. Claims 3 and 4, directly or indirectly

dependent from claim 2, are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04536/029001).

Dated: June 20, 2006

Respectfully submitted,

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